

REMARKS

Claims 1, 2, 9-14 and 21-36 are pending. Claims 1, 2, and 9-20 were withdrawn from consideration. Claims 21-29 track original Claims 3 and 4, except that independent Claim 21 has been revised to exclude compounds of formula (I). Claims 23-29 find support in the specification on page 10, see e.g., line 34 (Claim 23), lines 11-26 (Claims 24-28) and line 5 (Claim 29). Claims 30-35 find support in original Claims 3 and 15-20. Claim 36 tracks independent Claim 21, but substitutes the term “prevention” for the term “treatment”. Support for this claim is also found in original Claim 3. Methods for prevention or prophylaxis of brain disorders are described in the specification, for example, at page 1, line 8 and page 8, line 25. Accordingly, the Applicants do not believe that any new matter has been added.

ELECTION/RESTRICTION

The Applicants note that the restriction requirement has now been made final. New Claims 30-35 track original Claims 15-20, which were not included in the written restriction requirement because they were improperly dependent. Claims 30-35 properly depend from Claim 21. Accordingly, as these claims depend from Claim 21, which tracks prior Claim 3, the Applicants submit that these claims properly fall within elected Group II.

REJECTION – 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 3-8 were rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate written description. This rejection is moot in view of the cancellation of these claims. The invention, as described in Claim 21, is directed to the discovery that compounds which exert an effect of specifically potentiating an N-type  $\text{Ca}^{2+}$  channel activity may be used to treat brain disorders. Treatment of brain disorders by potentiation of N-type calcium channel

activity is described, for instance, on page 1, lines 5-11, page 3, lines 13-16, and page 4, lines 4-15 and page 8, lines 25-26. Prophylactic methods, such as that in new Claim 36, are described, for instance, in the specification at page 8, line 25. Thus, the inventors have discovered, and described within the present specification, that compounds which exert an effect of specifically potentiating an N-type  $\text{Ca}^{2+}$  channel activity may be used to prevent or treat brain disorders. Accordingly, the Applicants respectfully submit that the present claims meet the description requirement.

REJECTION – 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 3 and 4 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection is moot in view of the cancellation of these claims. The rejection expresses concern that there is insufficient descriptive support for the phrase "a compound having an effect of specifically potentiating an N-type  $\text{Ca}^{2+}$  channel activity".

Independent Claim 21 is directed to a method for treating a brain disorder using a compound having an effect of specifically potentiating an N-type  $\text{Ca}^{2+}$  channel activity. The specification clearly describes this subject matter, see e.g., page 1, lines 1-16. Moreover, a compound with this activity is exemplified in the specification, see pages 14 and 15, and methods for identifying such compounds are described on pages 11-15. Therefore, the Applicants submit that the specification would adequately describe and thus enable one with skill in the art to make and use compounds potentiating N-type  $\text{Ca}^{2+}$  channel activity and useful for treating brain disorders. Accordingly, the Applicants respectfully submit that this rejection would not apply to the present claims.

REJECTION – 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 5 and 6 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Applicants submit that these rejections are moot in view of the cancellation of these claims. The Applicants submit that the term “ar(lower)alkoxy” is clear when read in light of page 7, lines 8-10, of the specification, which describes this term and provides specific examples of an ar(lower)alkoxy group, e.g. groups such as benzyloxy, phenethyloxy, and phenylpropoxy.

REJECTION – 35 U.S.C. § 102

Claims 3-6 were rejected under 35 U.S.C. § 102(a) as being anticipated by Wang et al, Society for Neuroscience Abstracts, Vol. 26, Abstract No. 433. This rejection is moot in view of the cancellation of these claims and would not apply to the new claims, which exclude compounds of formula (I), such as FK960 (N-(4-acetyl-1-piperazinyl)-4-fluorobenzamide) of Wang et al.

REJECTION – 35 U.S.C. § 103

Claims 3-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang et al, Society for Neuroscience Abstracts, Vol. 26, Abstract No. 433. This rejection is moot in view of the cancellation of these claims and would not apply to the new claims, which exclude compounds of formula (I), such as FK960 of Wang et al.

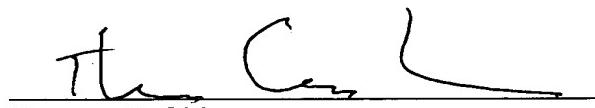
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CONCLUSION

In view of the above amendments and remarks, the Applicants respectfully submit that this application is now in condition for allowance. Early notification to that effect is earnestly solicited.

Respectfully submitted,

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